

REMARKS

Claims 1-9, 11-23, 25-36 and 38-73 are pending in the present application. No new matter has been introduced by way of the present amendment. Reconsideration of the present application is respectfully requested in view of the amendments and arguments set forth herein.

In the Office Action, claims 1-9, 11-23, 25-36 and 38-73 were again rejected under 35 U.S.C. § 102 as allegedly being anticipated by Cuiper (U.S. Patent No. 4,699,215). Applicants respectfully traverse the Examiner's rejections.

As asserted earlier, it is respectfully submitted that the latest applied reference – Cuiper – is even more far afield from the pending claims than Pallini (U.S. Patent Publication No. 2001/0045286), a reference that was asserted in the Final Office Action dated May 25, 2006. Thus, it is simply not understood how Cuiper can be asserted to anticipate the pending claims.

As an initial matter, it appears that the Examiner may not be giving any patentable weight to some of the express language in the claims. More specifically, it may be the case that the Examiner is ignoring the use of the “adapted to” language in the claims. If that is the case, that may be the basis for what Applicants believe is an improper rejection of the pending claims.

The use of “adapted to” language was specifically approved by the Board of Patent Appeals and Interferences in an appeal taken in the application that resulted in U.S. Patent No. 6,666,754. In the appeal of that case, the Board of Patent Appeals and Interferences did not sustain the Examiner's rejection under 35 U.S.C. § 112 for the use of the terminology “adapted to” in the claims at issue in that case. Decision on Appeal dated April 25, 2003. More specifically, in that case, the Examiner's rationale for the Section 112 rejection was as follows:

“The use of the terminology ‘adapted to’ makes the claim vague and indefinite because the scope of the claims cannot be ascertained, since it has been held the recitation that an element is ‘adapted to’ perform a function is not a

positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 U.S.P.Q. 138.

Decision on Appeal, p. 4. In reversing the Examiner's claim rejections under 35 U.S.C. § 112, the Board noted:

"The use of the terminology 'adapted to' in claim 21 does not render claims 21-32 vague and indefinite since the scope of the claim can be ascertained. As set forth by the Examiner, the recitation that an element is 'adapted to' perform a function is a limitation which requires only that the structure be able to perform the function. As such, the scope of the claims can be ascertained with a reasonable degree of precision and predictability.

Decision on Appeal, pp. 4-5. The use of "adapted to" language is also supported by the statements of the Board of Patent Appeals and Interferences in *Ex Parte Robert-A. Ollar*, 1994 WL 1687107, Bd. Pat. App. & Interf., 1994, which states:

"On the other hand, we are aware of support for a holding that 'adapted to' and 'whereby' clauses in claims further limit the claimed subject matter and should not be disregarded. For example, see *In re Venezia*, 530 F.2d 956, 958-59, 189 U.S.P.Q. 149, 151-52 (CCPA 1976). *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 U.S.P.Q.2d 1871, 1876 (Fed. Cir. 1990) recognizes (emphasis added) that: ... by deleting the preamble and all limitations that include 'adapted to,' 'whereby,' and 'thereby' ... the claims are reduced to mere collections of parts."

In view of the foregoing, it is respectfully submitted that the use of the "adapted to" language in the presently pending claims is proper. The scope of the claims containing the limitation is readily understandable. Thus, the limitation associated with such language must be considered a positively recited limitation. With this understanding, it is respectfully submitted that the pending claims are allowable.

In the previous response, Applicants specifically noted that the Examiner did not specifically identify the "first component" and "second component" in Cuiper. Response to Office Action Dated February 27, 2007, p. 3, ¶¶3-4. In the Final Office Action, the Examiner again did not specifically identify what structure the Examiner contends is the "first component"

and “second component” in Cuiper. Rather, the Examiner merely recited that the first and second components are not part of the claimed invention. Final Office Action, p. 3. The Examiner is correct that the “first” and “second” components are not part of the claimed invention, but it is legal error to ignore the express claim language that requires the claimed connector be adapted to engage the first and second components, as recited in the claims. That is, it is believed that to properly reject the pending claims, the Examiner must identify a connector that meets the limitations set forth in the claims. Since the Examiner has chosen to ignore this express limitation and/or because the Examiner has not specifically identified the “first” and “second” components set forth in the claims, the rejections set forth in the Final Office Action are improper.

Applicants would also like to address some additional comments made by the Examiner in the Final Office Action. The Examiner believes that the plunger 55 in Cuiper corresponds to a primary piston. Applicants respectfully disagree with the Examiner’s position. The plunger 55 in Cuiper is used to determine whether or not the dogs 41 are fully engaged in the grooves 13. Col. 3, ll. 50-65; Col. 4, ll. 25-50. The plunger 55 extends reciprocally through the threaded rod 49. The plunger is urged inwardly toward the wellhead housing by a spring 54. If the dogs 41 properly engage the grooves 13, the spring 57 pushes the plunger 55 inward until such time as it is flush with the outer surface of the knob 51, as indicated in Figure 6. If the dogs 41 do not fully engage the grooves 13, the plunger 55 will protrude some distance beyond the upper end of the knob 51, as shown in Figure 7. The diver, upon seeing the condition reflected in Figure 7, can rotate the knob 51 which causes the lower end of the threaded rod 49 to push against the dog 41. When the knob 51 contacts the recess shoulder 53, the dog 41 will be fully engaged with the grooves 13.

As thus understood, it is clear that the spring-biased plunger 55 in Cuiper is not a piston at all – much less a primary piston as asserted by the Examiner. The plunger 55 is part of “an indicator means for indicating whether or not the dogs 41 are in the fully engaged position, and also for forcing them into the engaged position if not.” Col. 3, ll. 50-53.

As to the statements regarding Cuiper’s lack of first and second secondary shoulders, set forth in claim 11, Applicants respectfully submit that the Examiner has again chosen to ignore the remainder of the claim language in claim 11 – the language that expressly recites that each of these first and second secondary shoulders are adapted to engage first and second shoulders, respectively, on the first and second components, respectively.

The Examiner’s contention that the three component components 25 (housing), 35 (backup segment) and 51 (knob) in Cuiper constitute a locking mandrel as recited in the claims is simply not credible. Based upon the aforementioned disclosure in Cuiper, the knob 51 is only intended to be used if, for some reason, the dogs 41 do not engage the grooves 13. Moreover, the claims recite that the locking mandrel, when actuated, is adapted to engage each of the plurality of locking segments at three spaced apart locations. In Cuiper, “there is a thread rod 49 for each dog 41” (Col. 3, l. 55) – a one-to-one correspondence. Thus, assuming for purposes of argument only, that the Examiner’s interpretation of Cuiper is correct, Cuiper still does not disclose or suggest a locking mandrel that, when actuated, engages a plurality of locking segments. In Cuiper, the knob 51 only engages a single locking element – not a plurality of locking elements. If for no other reason, the Examiner’s rejection of the pending claims based upon Cuiper is clearly improper.

In summary, Cuiper is very far afield from the inventions set forth in the pending claims. Among other things, claim 1 recites that each of the locking segments has a first primary locking

shoulder that is **adapted to engage the first component and a second primary locking shoulder** that is **adapted to engage the second component**. This basic structure is simply not present in Cuiper. As understood by the undersigned, at no point do the locking segments 41 (as identified by the Examiner) ever engage the as yet unidentified “first component” – perhaps it is the riser 17. It is not even clear that the connector 15 described in Cuiper could be modified so as to meet this express claim limitation. In any event, it is clear that each of the locking segments 41 (identified by the Examiner) do not have locking shoulders that are **adapted to engage BOTH** the first and second components as recited in the claims. For at least this reason, the Examiner’s anticipation rejection of all pending claims should be withdrawn. The above arguments apply equally with respect to all pending independent claims.

Additionally, dependent claim 11 further limits claim 1 by requiring that each of the locking segments have first and second secondary shoulders that area adapted to engage first and second secondary shoulders on the first and second components, respectively. Respectfully, there does not appear to be any structure in Cuiper that could even be argued to be the secondary shoulders that are adapted to engage the structures recited in dependent claim 11. This argument applies equally to other dependent claims having the same limitations as set forth in claim 11.

Dependent claim 16 recites that the locking mandrel is operatively coupled to a primary piston. Respectfully, as set forth above, Cuiper does not disclose or suggest such a structure. In fact, Cuiper teaches away from the use of such a hydraulic actuator in the connector disclosed therein. See, e.g., Col. 1, ll. 36-41 and 56-62. Dependent claim 17 further recites that the connector comprises a secondary release piston for use in moving the primary piston in claim 16. This argument applies equally to other dependent claims having the same limitations as set forth in claims 16 and 17.

From the foregoing, it is respectfully submitted that there are many aspects of the pending claims that are clearly not present in Cuiper. Accordingly, it is respectfully submitted that all pending claims are in condition for immediate allowance.

The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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